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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,880	08/05/2003	Eric Justin Gould	MNKYP011A	1594

37141 7590 08/01/2005

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EXAMINER
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CARDONE, JASON D

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,880

Applicant(s)

GOULD, ERIC JUSTIN

Examiner

Jason D. Cardone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's election of Group II (claims 23-91) in the reply filed on 5/18/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 1-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

2. This application contains claims 1-22 that are drawn to an invention nonelected without traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 23-91 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 23-91 disclose computer readable

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medium and instructions but the specification does not specifically disclose computer readable medium or instructions.

5. Claims 23-91 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not teach how computer readable medium storing instructions would open and display icons.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 43 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 43 and 71 recite the limitation "the media products". There is insufficient antecedent basis for this limitation in the claim, since the claims they depend on include "a search engine or media products".

### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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9. Claims 23-91 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims disclose computer readable medium storing instructions. The process is not tangibly limited to a product that is within and enabled by the specification. Therefore, claims 23-91 are not limited to tangible embodiments.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-7 of USPN 6,693,236 contains every element of claims 23, 59, 74, 81, 86 and 90 of the instant application and as such anticipates claims 23, 59, 74, 81, 86 and 90 of the instant application. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a

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genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 23-39, 44-53, 59-67, 72-78 and 81-91 are rejected under 35

U.S.C. 102(e) as being anticipated by Khan, USPN 6,546,393.

14. Regarding claim 23, Khan discloses a computer readable medium storing instructions that when executed by a personal computer connected to a network are capable of causing the personal computer to: display a meta-folder containing a search object configured by a user; open the meta-folder [ie on-line bookmark icons, Khan, col. 14, line 31 – col. 15, line 12];

automatically initiate the resolution of the search object by searching the network and the personal computer for conventional objects that satisfy the search object [ie. drill down to a subcategory, Khan, col. 12, line 55 – col. 13, line 23 and col. 20, line 30 – col. 21, line 16]; and

display icons representing the conventional objects, wherein the icons are displayed on a user interface of the personal computer [Khan, col. 14, lines 35-64 and col. 20, line 30 – col. 21, line 16].

15. Regarding claims 23-31, Khan further discloses the network includes a local area network, a wide area network and/or the Internet and the network includes a collection of storage systems for storing at least some of the conventional objects [Khan, col. 10, lines 60-67 and col. 14, lines 35-64].

16. Regarding claim 32, Khan further discloses the network includes a user server connected to the personal computer [Khan, col. 4, lines 45-67].

17. Regarding claims 33 and 34, Khan further discloses the user server stores the meta-folder and at least some of the conventional objects [Khan, col. 14, lines 35-64].

18. Regarding claims 35-39, Khan further discloses the user server is connected to the personal computer via a LAN, WAN or Internet and the user server is connected to a content server via the Internet, wherein the content server is a web-page server, an FTP server or a news server [Khan, col. 10, lines 60-67 and col. 14, lines 35-64].

19. Regarding claims 44 and 45, Khan further discloses the personal computer to initiate a transfer of the meta-folder from the user to another user via the network,

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wherein the transfer occurs through electronic mail [Khan, col. 21, line 55 – col. 22, line 32].

20. Regarding claim 46, Khan further discloses the conventional objects include conventional folders, conventional files, electronic mail, notes, contact or address book items or files containing text, audio or video information [Khan, col. 14, line 31 – col. 15, line 12].

21. Regarding claims 47-49, Khan further discloses the search object includes wildcard characters and the meta-folder includes indicia indicative of a search function, wherein the indicia is a magnifying glass [Khan, col. 20, line 40-64].

22. Regarding claims 50 and 51, Khan further discloses the meta-folder includes descriptive text, wherein the descriptive text describes the search object [Khan, col. 14, lines 44-64 and col. 20, line 40-64].

23. Regarding claims 52 and 53, Khan further discloses the personal computer to display the meta-folder, the icons representing the conventional objects and other objects on a single screen or intermingling screens of the user interface [Khan, col. 22, lines 35-63].

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24. Regarding claims 59-67, 72-78 and 81-91, claims 59-67, 72-78 and 81-91 have similar limitations as claims 23-39 and 46-53. Therefore, the similar limitations are disclosed under Khan for the same reasons set forth in the rejection of claims 23-39 and 46-53 [Supra 23-39 and 46-53].

***Claim Rejections - 35 USC § 103***

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 40-43, 54-58, 68-71, 79 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan in view of Fritsch, USPN 6,233,682.

27. Regarding claims 40-43, Khan substantially discloses the claimed invention but does not specifically disclose the user server is connected to a vendor server via the internet, wherein the meta-folder is stored on the vendor server or the user server, wherein the vendor server includes a search engine of media products and wherein the media products include books, video tapes, DVDS, CDs and audio cassettes. However, Fritsch, in the same object searching field of endeavor, does disclose a server is connected to a vendor server via the internet, wherein a folder is stored on the vendor server, wherein the vendor server includes a search engine of media products and wherein the media products include books, video tapes, DVDS, CDs and audio cassettes [Fritsch, col. 3, line 40 – col. 4, line 46]. It would have been obvious to one of

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ordinary skill in the art to incorporate a vender server with multimedia products, taught by Fritsch, into the search engine system, taught by Khan, in order to distribute digital music.

28. Regarding claims 54-55, Khan-Fritsch further discloses the conventional objects pertain to music, wherein the personal computer to initiate playing the music [Khan, col. 14, lines 44-64] [Fritsch, col. 1, lines 10-64 and col. 4, lines 47-67].

29. Regarding claims 56-58, Khan-Fritsch further discloses the personal computer to generate icons that indicate whether the music is owned or un-owned, wherein the personal computer to initiate a purchase of the music and the personal computer to provide a link from which the user can purchase the music [Khan, col. 11, lines 40-61] [Fritsch, col. 5, line 25 – col. 6, line 32].

30. Regarding claims 68-71, 79 and 80, claims 68-71, 79 and 80 have similar limitations as claims 40-43 and 54-58. Therefore, the similar limitations are disclosed under Khan-Fritsch for the same reasons set forth in the rejection of claims 40-43 and 54-58 [Supra 40-43 and 54-58].

### ***Conclusion***

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

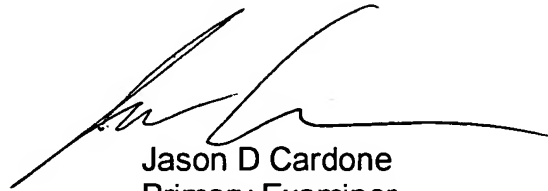
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'J. Cardone', with a long horizontal flourish extending to the right.

Jason D Cardone  
Primary Examiner  
Art Unit 2145

July 26, 2005